

REMARKS

Applicants express appreciation to the Examiner for conducting a telephone interview with Applicant's attorney on October 4, 2004. The present Amendment is in response to the Examiner's Office Action mailed October 15, 2004. Claims 1-13 and 20-37 were pending at the time of the Office Action. By this response, Applicant has amended claims 23, 29 and 31, and withdrawn claims 7-13 and 22 from consideration. Applicant respectfully submits that the amendments to claims 23, 29 and 31 are supported in the specification and entry thereof is respectfully requested. As such, Applicant respectfully requests reconsideration of claims 1-6, 20-21 and 23-37 in view of the following remarks.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

A. Restriction Requirement

Page 2 of the Office Action asserted a restriction requirement under 35 U.S.C. § 121. The Office Action identified two groups of claims as follows:

- I. Claims 1-6, 20-21, 23-37, drawn to a product, classified in class 379, subclass 449.

II. Claims 7-13 and 22, drawn to process of making, classified in class 364, subclass 138+.

As indicated in the Office Action on page 2, during a telephone conversation with Applicant's attorney on October 4, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 20-21, 23-37. Applicant hereby reaffirms election of Group I without traverse. Applicant hereby withdraws, without traverse, claims 7-13 and 22. Applicant reserves the right to prosecute claims 7-13 in a continuation application if Applicant so desires.

B. Rejection Under 35 U.S.C. § 112, First Paragraph

On page 3 of the Office Action, claims 1-6, 20-21 and 23-37 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement, in that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Office Action asserted that in claims 1 and 23 the limitations of "base portions are configured to be selectively positioned closer together or farther away from each other" and in claim 29 the limitations of "second portion comprising a space increasing or decreasing the size of the space" is new matter. The Office Action asserted three arguments as to why the claims are not supported in the original disclosure and are considered as new matter. Each of these arguments will now be addressed.

First, the Office Action asserted that while the specification discloses that the shoulder rest is made of flexible material and it is common to have shoulder rests made of flexible material in order to comfortably rest on the user's shoulder, that there is no original disclosure

about “base portions are configured to be selectively positioned closer together or farther away from each other” or “second portion comprising a space increasing or decreasing the size of the space.” Applicant respectfully disagrees.

The Examiner is correct in stating that the two base portions 102, 103 and main body of the rest 100 can be formed from flexible material. In fact, the Specification on page 6, line 22 states “the phone rest is preferably made of a flexible material and has a cut-out or concave portion between two base portions that contact the phone handset.... In this way as will be described below, the [phone] rest of the present invention can conform to handsets with widely varying shapes and contours.” Thus, the specification states that the handset is able to “conform” to the varying sizes of telephone handsets. This is partly in due to the flexible material from which the phone rest is constructed. It is also due, in part, to the cut-out or concave portion 106.

Applicant also directs the Examiner’s attention to page 7 of the Specification, lines 16-20 where it states:

between the two base portions (102, 103), the main body of the rest (100) retreats inward to form a concaved or cut-out portion (106). Because of the concave portion (106) between the two base portions (102, 103), the rest (100) of the present invention can be fit to a back surface of a phone handset that is flat or curved.

This description of the phone rest states that the phone rest “can be fit” to differently shaped telephone sets due to the cut-out portion 106.

Applicant now refers the Examiner to Figure 1 of the specification where it shows an exemplary embodiment of a handset 100. Assume, *arguendo*, that the flexible strip 104 is not present, leaving a top portion 101 and two base portions 102, 103 having a cut-out portion 106 therebetween. Assume that a user desires to use the rest 100 on a handset that is smaller than the

distance between the terminal ends of the base portions 102 and 103. As the specification clearly supports, the flexible material of the phone rest in combination with the cut-out portion 106 allows the base portions 102 and 103 to “conform” or “to be fit” to the smaller sized handset. Inherently, this includes that the “base portions are configured to be selectively positioned closer together or farther away from each other” as recited in claims 1 and 23. Further, it allows for “increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets” as recited in claim 29.

This argument is further reinforced by analysis of the original claims filed in the present application. In original claim 1, it recites “base portions for abutting against telephone handset; and a cut-out portion between said base portions allowing said shoulder rest to conform to differently shaped [sic] telephone handsets”. Further, in claim 3, which depends from claim 1, it recites “a flat, flexible strap of material between said base portions and partially enclosing said cut-out portion.” In at least this embodiment, the limitations require that the base portions “abut” against the telephone handset and “conform” to differently shaped handsets even in the present of the flexible strap of material between the base portions. In order to meet this requirement, one way that the base portions can “abut” against a telephone handset is by having “base portions []configured to be selectively positioned closer together or farther away from each other” as recited in claims 1 and 23 or by “increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets.” In presenting this particular argument, Applicant **does not** assert that the flexible strap of material is required in all embodiments. Applicant simply asserts this argument to reinforce that the limitations of claim 1, 23 and 29 are inherently supported in the specification. As such, Applicant respectfully submits that there is original disclosure to support the above limitations.

Second, the Office Action asserted that the fact that the Applicant provided two different sizes of shoulder rests (Figure 1 and Figure 2) to fit different sizes of handsets is the basis for Applicant's argument that the "base portions are configured to be selectively positioned closer together or farther away from each other" and "increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets." Applicant respectfully disagrees. Applicant has never asserted this argument during prosecution of the present invention. This argument was asserted independently by the Examiner during the telephone conference of October 4, 2004.

However, in order to respond to this argument, Applicant notes that support in the specification for the limitations of the claims can be found solely on the basis of the disclosure of Figure 1 **without any reference to the embodiment of Figure 2.** In fact, the immediately foregoing argument that Applicant has made to support original disclosure of the specification referenced portions of the specification that relate to Figure 1 and not to Figure 2. Applicant does agree that the specification discloses that Figure 2 is an embodiment which may be used for smaller sized handsets. However, the argument that it is only the comparison of Figures 1 and 2 which provides the support in the disclosure for the limitations has never been one relied upon by the Applicant.

Third, the Examiner has asserted that each embodiment of the invention is required to have a strip across the base portions. If Applicant understands the Examiner's argument correctly, Applicant believes that the Examiner is arguing that it could not be possible for the base portions to be selectively positioned closer together or farther away from each other because it would cause the strip to fold upon itself or at least create a non-adhesive area between the strip and the handset.

Applicant wishes to clarify that only independent claim 23 requires a strip extending between the first and second base portions. There is nothing in the Applicant's specification which requires the flexible strip as a necessary part of the invention. Applicant acknowledges that the embodiments disclosed in the specification disclose that a flexible strip can be used "to provide more contact between the rest (100) and the phone handset to better secure the rest (100) to the handset." Specification, page 7, lines 25-27. The specification goes on further to say "the bottom of the strip (105) and the base portions (102, 103) may be covered with an adhesive (108)." The fact that the Applicant used the term "may" indicates that the bottom of the strip does not always have to be covered with an adhesive. In addition, page 7 of the specification states that the flexible strip is only "preferable". See specification, page 7, line 23. A preferable element has never been held to limit a claim to require the recitation of the preferable element. Furthermore, Applicant notes that none of the originally filed independent claims required a flexible strip. Thus, Applicant respectfully asserts that the invention is not limited to those having a flexible strip.

Having clarified that the flexible strip is not a required element of the invention, Applicant believes that the Examiner is attempting to argue that the possibility of forming non-adhesive areas or folded areas should the base portions of the phone rest be pushed closer together would render the invention inoperable. Applicant is uncertain where the Examiner finds basis for this argument in the Applicant's specification and argues that the exact opposite inference can be made and is, in fact, **supported by the Applicant's specification**. That is, the Applicant's specification contemplates that folded areas or non-adhesive areas could occur between the strip and the phone rest, and, even in the existence of such, the phone rest is still operable.

Applicant submits that this allegedly undesirable result was inherently contemplated and accounted for in the present specification as evidenced by the existence of the embodiment of Figure 2 which provides for a phone rest to conform to smaller sized handsets. In the event that such non-adhesive areas or folded areas are considered undesirable by a user, the user could use a smaller sized phone rest to reduce the possibility of this happening. The specification teaches that "the second embodiment merely illustrates a shoulder rest with the same features and elements as the first embodiment which are sized and proportioned differently to accommodate a smaller class of telephone handsets." Specification, page 9, lines 6-8. That is, if indeed it is a disadvantage to have folded or unadhesive areas between the flexible strip and the handset, the embodiment of Figure 2 can be used.

However, even in the embodiment of Figure 1 (or even Figure 2), should folded or non-adhesive areas occur in those embodiments having a flexible strip, this would still not render the present invention inoperable. In other words, it is possible to have a phone rest in which the "base portions [are] configured to be selectively positioned closer together or farther away from each other" or that provides for "increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets" and also have folded or unadhesive areas between the flexible strip and the handset. There is nothing in the specification or claims that requires the entire surface area of the flexible strip to come into contact with the handset.

As such, the Applicant respectfully submits that each of the arguments set forth by the Examiner as to the written description has been adequately addressed. As such, Applicant respectfully requests that the written description rejection with respect to claims 1-6, 20-21, 23-37 be withdrawn.

C. Reasserted Rejections Under 35 U.S.C. § 102 and 103

On page 4 of the Office Action, claims 1-2, 6, and 29-35 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,817,139 (Russo). On page 5 of the Office Action, claims 3-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,817,139 (Russo) in view of United States Patent No. 6,341,163 (Castle et al.). Pages 6 through 7 of the Office Action rejected claims 1-2 and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,961,223 to Sutton (the Sutton '223 reference) in view of U.S. Patent No. 4,759,058 to Sutton (the Sutton '058 reference). However, the Office Action used a combination of references in order to assert a prima facie case of obviousness. Therefore, Applicant will treat this rejection as an obviousness rejection for purposes of responding to this rejection. On page 7 of the Office Action, claims 3-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of United States Patent No. 4,961,223 (Sutton) in view of United States Patent No. 6,341,163 (Castle et al.).

The Office Action stated with regard to these reasserted rejections that new matter had not been considered or entered. It thus appears, that the Examiner reasserted the same rejections using the same arguments as were made in the previous Office Action mailed April 14, 2004, with the exception that the Examiner has extended the rejections with respect to some of the new claims that were added in the previous response. In the previous response filed by the Applicant, amendments were made to the independent claims which Applicant believed distinguished the Applicant's invention over the cited references. The Applicant respectfully invites the Examiner to point out where in the cited references, for example, it teaches or suggests, "base portions are configured to be selectively positioned closer together or farther away from each other" as recited in independent claim 1, "first and second base portions are configured to be selectively

positioned closer together or farther away from each other” as recited in independent claim 23, or “means for increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets” as recited in independent claim 29.

In reasserting the previous anticipation and obviousness rejections, the Examiner noted on page 11 of the Office Action with respect to the previous response filed on June 23, 2004, that the Applicant mainly argues about the features of selectively positioning the base portions closer together or farther away from each other and asserts that this issue has been addressed in various rejections above. However, Applicant believes that because the anticipation and obviousness rejections were reasserted verbatim, the Examiner has not adequately taken into account the amendments made in the previous office action response. Indeed, Applicant respectfully believes that the claims as amended in the previous office action sufficiently distinguished over the cited references. As such, Applicant respectfully requests that the reasserted anticipation and obviousness rejections be withdrawn.

D. New Rejection Under 35 U.S.C. § 103(a)

On page 8 of the Office Action, claims 1-6, 21, 23, 25-33 and 35-36 are rejected under 35 U.S.C. §102(e) as being anticipated by the Castle reference. Particularly, the Office Action asserted that with respect to independent claim 1, the Castle reference shows a shoulder rest comprising a first portion (400, 208, 204 in Fig. 13D) for abutting against a user’s shoulder; a second portion comprising a space (between 196, 198; or 26, 28), the second portion comprising means (196, 198; or 26, 28) for increasing or decreasing the size of the space so that the shoulder rest can conform to differently shaped handsets; and means (loop formed by 196, 198; or 26, 28) for connecting the second portion to a handset. Applicant first wishes to clarify that it appears that the Examiner has read the limitations of independent claim 29 on the Castle reference and

not the independent limitations of claim 1 as asserted in the Office Action. Nevertheless, each of the independent claims can be distinguished over the Castle reference.

With regard to the embodiment of Fig. 13D of the Castle reference to which the Office Action refers, the Castle reference discloses a

decorative member 400 is in the shape of a shark. The underbelly of shark is secured to attachment body 208 of attachment member 206 by suitable securement means, e.g., glue, Velcro, two-sided tape, and the like. Referring to Fig. 13C, securement member 190 is mounted to handset 10 by stretching loops 196, 198 around regions 12, 14 thereof. Thereafter, as shown in Fig. 13D, attachment member 206 with shark 400 mounted thereon, is slid within channels 204 of securement member 190, as shown by arrow 402. Hooks 214 serve to attachment member 206 in position relative to securement member 190. As shown in Fig. 13E, shark 400 provides a novel appearance to handset 10 and based on the curvature of the shark's back, may provide enhanced comfort to the user when utilizing handset 10. Such enhanced comfort may be increased through the fabrication of shark 400 from soft materials and/or by filling shark 400 with compressible or flowable materials.

'163 patent, col. 10, ll. 56-67, col. 11, ll. 1-5. Thus, the Castle reference teaches loops 196, 198 are stretched around portions of the handset 10 to secure the shoulder rest to the handset. Because the loops 196, 198 stretch to wrap around the handset, the Castle reference does not teach "said terminal ends of said base portions configured for abutting against different longitudinal portions of a back side of said telephone handset" as recited in independent claim 1. As such, Applicant respectfully requests that the anticipation rejection with respect to claim 1 be withdrawn.

With regard to independent claim 23, Applicant respectfully submits that the Castle reference lacks teaching of "a flexible strip extending between the terminal ends of the first and second base portions." The Office Action asserted on page 10 that Figure 2 of the Castle reference teaches a strap 22 between the base portions 26, 28. However, as discussed above, Applicant submits that claim 23 requires that the flexible strap extend between "the terminal

ends” of the first and second base portions. Because the Castle reference does not teach “a flexible strip extending between the terminal ends of the first and second base portions,” Applicant respectfully requests that the anticipation rejection with respect to claim 23 be withdrawn.

With respect to independent claim 29, Applicant respectfully submits that the Castle reference does not teach “means for connecting the second portion to a handset so that the terminal ends of the first and second base portions are configured to abut against different longitudinal portions of a back side of a telephone handset.” As discussed above with respect to claim 1, the Castle reference does not teach that the loops 196, 198 are “configured to abut against different longitudinal portions of a back side of a telephone handset.” As such, Applicant respectfully requests that the anticipation rejection with respect to claim 29 be withdrawn.

Claims 2-6, 21, 25-28, and 30-33, 35 and 36 depend from independent claims 1, 23 and/or 29 and thus incorporate the limitations thereof. As such, Applicant respectfully submits that claims 2-6, 21, 25-28, and 30-33, 35 and 36 are distinguishable over the cited references for at least the same reasons discussed above with respect to independent claims 1, 23 and/or 29. As such, Applicant respectfully requests that the anticipation rejection with respect to claims 2-6, 21, 25-28, and 30-33, 35 and 36 be withdrawn.

On page 11 of the Office Action, claims 20, 24, 34 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Castle reference in view of the Russo reference. The Office Action asserted that the Castle reference shows the mounting of the shoulder rest onto the handset. However, the Castle reference does not teach an adhesive for such mounting. The Office Action further asserted that the Russo reference teaches providing an adhesive (i.e., reference numeral 28) for mounting the shoulder rest onto a handset. Applicant respectfully

submits that even if the Russo reference teaches mounting a shoulder rest using an adhesive, that claims 20, 24, 34 and 37 depend from independent claims 1, 23 and/or 29 and thus, incorporate the limitations thereof. As such, Applicant respectfully submits that claims 20, 24, 34 and 37 are distinguishable over the Castle and Russo references for at least the same reasons discussed above with respect to claims 1, 23 and/or 29.

In addition, Applicant respectfully submits that the combination of the Castle and Russo references do not teach or suggest the limitations of claims 1, 23, and/or 29. The Russo reference teaches a shoulder rest having a curvilinear band 32 and track 26. The curvilinear band 32 comprises a pedestal 34 on a top portion thereof. A figurine 36 composed of a firm, yet resilient-surface material is attached to pedestal 34. The curvilinear band 32 also has leg portions 40, 42 (numerals added by the Examiner for purposes of discussion). The leg portions 40, 42 are connected to a base 38. The base 38 of curvilinear band 32 includes a pair of co-linear flanges 20 curving under the base. The curvilinear track 26 is attached to a handset handle 24 by suitable adhesive means (e.g., contact cement strip 28). The cradle 10 then slidably engages track 26. As shown in Figure 3, the curvilinear band 32 is a **fixed member**.

As such, Applicant respectfully submits that the Russo reference **teaches away** from the limitation of **“wherein at least a portion of said base portions are configured to be selectively positioned closer together or farther away from each other so that said shoulder rest can conform to differently shaped telephone handsets”** as recited in independent claim 1, **“wherein at least a portion of the first and second base portions are configured to be selectively positioned closer together or farther away from each other”** as recited in independent claim 23, and **“means for increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets”** as recited in independent claim 29. That is, were the

stretchy loops 196, 198 of the Castle reference modified to include the rigid material that forms band 32 of the Russo reference, it would **destroy the intended function** of the Castle reference. As such, Applicant respectfully submits that the combination of the Castle and Russo references does not teach or suggest the limitations of claims 1, 23 and/or 29. Because claims 20, 24, 34 and 37 depend from claims 1, 23 and/or 29, Applicant respectfully submits that claims 20, 24, 34 and 37 are distinguishable over the combination of the Castle and Russo references and thus requests that the obviousness rejection with respect to claims 20, 24, 34 and 37 be withdrawn.

No other rejections or objections were presented in the Office Action.

E. Conclusion

In view of the foregoing, Applicant believes that claims 1-6, 20-21 and 23-37 are allowable. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 12 day of January 2005.

Respectfully submitted,



SARA D. JONES

Registration No. 47,691
Attorney for Applicant
Customer No. 022913